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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,276	09/08/2003	Wen-Hsiang Hsiao	HSIA3021/EM	7139
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BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			EXAMINER FUREMAN, JARED	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/656,276

Applicant(s)

HSIAO, WEN-HSIANG

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The use of the trademarks CompactFlash, Memory Stick and Smart Media has been noted in this application (see page 1, lines 18-20, of the specification). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 contains the trademark/trade name CompactFlash, Memory Stick and Smart Media (in abbreviated form, CF, MS and SM, respectively) (see claim 1, lines 12 and 19). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade

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name is used to identify/describe memory cards having particular specifications and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le et al (US 6,738,259 B2) in view of the admitted prior art.

Le et al teaches a 4-in-1 card reader (adapter 10) for a PCMCIA interface (port 7, of computing device 4), said card reader comprises: a cartridge (see figure 2) having a shape in coincidence with an insertion slot of said PCMCIA interface, and being provided therein with an electric connecting circuit (11, see figure 1 and column, 3 lines 24-26); a first connector (also labeled 11, see figure 2 and column 3, lines 48-50) of a specification in coincidence with of said PCMCIA interface (see column 2, lines 10-14, and column 3, lines 13-15), being fixed on a front said cartridge to connect with said electric connecting circuit; a second connector (a particular slot and corresponding connecting area) provided on a read end of said cartridge (see figure 2) to connect with said electric connecting circuit, and having a plurality of insertion slots (the different sizes of slot 13 represent a plurality of insertion slots) for memory cards of specifications including those of MMC, MS (see figure 7) and SD (see figure 8) memory cards on a side thereof other than another side connecting with said electric connecting circuit,

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connecting pins (contact areas 26A-26C) are provided at said insertion slots to connect with said connecting circuit; a third connector (a slot and corresponding connecting area) provided on said read end of said cartridge to connect with said electric connecting circuit, and having an insertion slot for memory cards of specifications including SM (see figure 6) on a side thereof other than said another side connecting with said electric connecting circuit; thereby a card reader is formed for connecting an electric device (computing device 4) and for inserting therein and connecting thereto memory cards taken among those of four specifications, that is to say, those of MMC, MS, SD, and SM memory cards through said PCMCIA interface as well as for proceeding to data reading, exchanging and transferring with said electric device; wherein one of said insertion slots on said second connector is common for an MMC memory card and an SD memory card (see figure 3, showing a common MMC and SD card slot and contact area 26C), said insertion provided on an inner side thereof with a channel with a width and a thickness in coincidence with those of an MMC memory card and an SD memory card to prevent wrong insertion of a memory card (see figures 3-5); wherein said first connector is connected with said connecting circuit by using said connecting pins, a coupling part provided on a side of said first connector other than said another side connecting with said connecting circuit forming inserting connection with said PCMCIA interface; said cartridge has an upper cover and a lower cover to envelop a part of a main body of said connecting circuit and a part a main body of said first connector to expose said coupling part of said first connector at said front side of said cartridge (housing 18 serves as an upper and lower cover); wherein said cartridge

is provided on a rear part thereof with a cover to envelop main parts of said second and third connectors (see figures 1-8, column 1 lines 23-47, column 2 lines 10-14, column 2 lines 17-28, column 2 line 65 - column 4 line 30). Le et al also teaches that the apparatus could be modified to accommodate alternative or additional memory card sizes (see column 6, lines 60-62).

Le et al fails to specifically teach the card reader being a 7-in-1 card reader; the card reader having insertion slots for CF, MD, and XD memory cards; wherein one of said insertion slots on said second connector is common for a CF memory card and an MD memory card, said insertion slot is provided on an inner side thereof with a channel with a width and a thickness in coincidence with those of an CF memory card and an MD memory card to prevent wrong insertion of a memory card.

However, Le et al does teach that the card reader could be modified to accommodate additional memory card sizes (see column 6, lines 60-62, of Le et al) and the use of a common slot/contact area for memory cards having similar specifications (the common MMC and SD slot and contact area 26C, for example, see figure 3). Furthermore, the admitted prior art teaches that CF, MD, and XD memory card specifications were old and well known to those of ordinary skill in the art at the time of the invention (see page 1, lines 16-21, of the specification, under "Description of the Prior Art").

Therefore, in view of Le et al and the admitted prior art teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the card reader as taught by Le et al, the card reader being a 7-in-1 card reader;

the card reader having insertion slots for CF, MD, and XD memory cards; wherein one of said insertion slots on said second connector is common for a CF memory card and an MD memory card, said insertion slot is provided on an inner side thereof with a channel with a width and a thickness in coincidence with those of an CF memory card and an MD memory card to prevent wrong insertion of a memory card, in order to increase the number of card standards usable with the card reader, thereby further reducing the number of card readers required.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le et al as modified by the admitted prior art as applied to claim 1 above, and further in view of Pua et al (US 2002/0178307 A1).

Le et al as modified by the admitted prior art fails to specifically teach that said cover is further provided with indicating lights connecting respectively to said insertion slots of said second and third connectors; said indicating lights show states of operation of memory cards in said insertion slots.

Pua et al teaches a card reader having connectors and insertion slots (30) for multiple specifications of memory cards, the card reader including indicating lights (indicators 35, such as LED's, see figure 1 and paragraph 39) showing states of operation of memory cards in the insertion slots.

In view of Pua et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the card reader as taught by Le et al as modified by the admitted prior art, said cover is further provided with indicating lights connecting respectively to said insertion slots of said second and third connectors;

said indicating lights show states of operation of memory cards in said insertion slots, in order to provide a visual indication to a user that a memory card is being accessed, thereby confirming that the card reader is operating and preventing the user from prematurely removing a memory card before access to that memory card is complete, thereby preventing incorrect operation of the card reader.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Le et al (US 2004/0184246), Yiu (US 6,786,415 B2), Liu et al (US 6,776,348 B2), Yen (US 6,612,492 B1), Klatt et al (US 6,097,605), Liu (US 6,751,694 B2), Chen et al (US 2003/0098346 A1), Sun (US 2002/0065001 A1), Nishimura (US 2001/0039129 A1), Matsushita et al (US 6,700,788 B2), Chen (US 6,672,904 B1), and Kung et al (US 6,540,523 B1) all teach memory card readers compatible with a plurality of memory card specifications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Jared J. Fureman*  
Jared J. Fureman  
Examiner  
Art Unit 2876

March 5, 2005